

REMARKS

Claims 1, 13, and 23 are amended to include embedded reconfiguration control, and claims 5, 17, and 26 are cancelled without prejudice. The allowability of claims 16 and 28 is acknowledged. However, the claims remain in dependent form since other amendments have been made to the claims. New claims 29–35 are added to claim the invention in alternative language. Claims 1–4, 6–16, 18–25, and 27–35 remain for consideration, and all claims are thought to be allowable over the cited art.

Rejections for Double Patenting

The Office Action does not establish that the claims of the present application and the claims of application number 09/968,439 would violate the doctrine of non-statutory double patenting. Non-statutory double patenting by the applications is not shown because the Office Action simply recites portions of the preambles of the claims in each application, without any analysis of the differences in the limitations in the bodies of the claims. It is respectfully submitted that an invention is defined by the claim as whole, not the preamble. Therefore, in order to establish double patenting, the rejection must address the differences between the claims in their entirety, not simply a paraphrase of the preambles. The MPEP (804 (II) (B) (1)) clearly sets forth the requirements for making a non-statutory double patenting rejection:

Any obviousness-type double patenting rejection should make clear:

(A) The differences between the inventions defined by the conflicting claims — a claim in the patent compared to a claim in the application; and

(B) The reasons why a person of ordinary skill in the art would conclude that the invention defined in the claim in issue is an obvious variation of the invention defined in a claim in the patent.

The Office Action does not address the claim limitations, and therefore, ignores differences between the inventions as defined by the claim limitations. Thus, the differences between the inventions have not been considered in the Office Action, and non-statutory double patenting is not established.

Rejections Under 35 USC §103(a)

The Office Action does not establish that claims 1-15 and 17-27 are unpatentable under 35 USC §103(a) over the paper, "Diagnosis of Digital/Analog Measurement System with Application of Test Bus and Distributed Diagnostic Subsystem" by Badzmirowski, Gonera and Kern (hereinafter "Badzmirowski") in view of U.S. Patent No. 6,144,933 to Guccione (hereinafter "Guccione"). The rejection is respectfully traversed because the Office Action fails to show that all the limitations are suggested by the references and fails to provide a proper motivation for modifying the teachings of Badzmirowski with teachings of Guccione.

However, the independent claims are amended to include the reconfiguration controller, for example, as in claim 5. The limitations of claim 5 are not addressed in the Office Action, nor are the limitations thought to be suggested by the cited art. Therefore, the independent claims and the claims depending therefrom are patentable over the Badzmirowski-Guccione combination.

The Office Action cites Guccione's col. 9, ll. 21-28 as suggesting the limitations of and related to the reconfiguration of a PLD as in cancelled claims 17 and 26. However, this portion of Guccione neither teaches nor suggests the claimed reconfiguration of the PLD based on the output signals from the device. Guccione's paragraph appears to generally indicate that his system may be used in debugging designs, developing tools, and debugging devices. There is no apparent suggestion that during the testing the device under test is reconfigured based on the output signals from the device. Clarification is requested if the rejection is maintained. Otherwise, the rejection should be withdrawn.

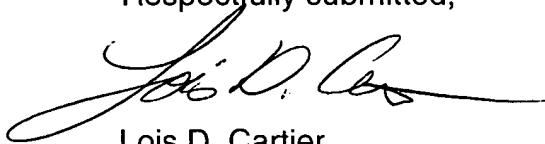
Other claim limitations not shown by the Office Action to be suggested by the Badzmirowski-Guccione combination, include, for example, the access controller that is configured to be embedded within an electronic system. It is respectfully submitted that neither Badzmirowski nor Guccione is shown to suggest this feature. Furthermore, the alleged motivation for making the combination is conclusory and improper. That is, the Office Action does not provide evidence to support the assertion that the combination would provide any more parallelism in testing than

would be achievable without the combination. Therefore, the Office Action does not establish a *prima facie* case of obviousness.

CONCLUSION

Reconsideration and a notice of allowance are respectfully requested in view of the Amendments and Remarks presented above. If the Examiner has any questions or concerns, a telephone call to the undersigned is invited.

Respectfully submitted,



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I hereby certify that this correspondence is being deposited with the United States Postal Service as first-class mail in an envelope addressed to: Commissioner for Patent, P.O. Box 1450, Alexandria, Virginia 22313-1450, on December 7, 2004.

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